



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/848,773

05/19/2004

Sean T. Dycus

2727 CON

7228

7590

10/20/2006

Mark Farber, Esq.
U.S. Surgical
A Division of Tyco Healthcare Group, LP
150 Glover Avenue
Norwalk, CT 06856

EXAMINER

PEFFLEY, MICHAEL F

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/848,773

Applicant(s)DYCUS ET AL. C**Examiner**

Michael Peffley

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :8/26/04; 5/11/05; 3/17/06; 6/5/06.

Information Disclosure Statement

Applicant should note that the large number of references in the attached IDS have been considered by the examiner in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. **See MPEP 609.05(b)**. Applicant is requested to point out any particular references in the IDS which they believe may be of particular relevance to the instant claimed invention in response to this office action.

Specification

The disclosure is objected to because of the following informalities: the first sentence of the specification should be amended to provide the most current status (i.e. US Patent No.) for the related application.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Yates et al (H1,904).

Yates et al disclose an endoscopic device for the sealing and cutting of tissue. In particular, the device includes jaw members for sealing tissue, the jaw members

Art Unit: 3739

creating a desired gap (via the compression zone) between the jaw members (see, for example, Figures 6, 11-14 and 22). Yates et al further disclose the device provides a closure pressure within the ranges set forth by applicant (see col. 4, lines 25-35).

Electrodes are provided on the jaw members for providing RF energy to tissue to cause sealing of the tissue in order to prepare tissue to be cut along a cut line.

Claims 1 and 2 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. The inventive subject matter of claims 1 and 2, that is the subject matter of the tissue stop and the closure pressure of the jaws, is also the same claimed subject matter in US Serial No. 10/849,432, which application has no common inventor with the instant application. It is noted that the '432 application claims are drawn to a device for open surgical procedures as opposed to the endoscopic device of the instant application claims. However, the specific type of device is relatively unimportant to the inventive concept being claimed. In comparison, it would be similar to one group of inventors claiming a carburetor used on an automobile, and another group of inventors claiming an identical carburetor on a truck. It appears unlikely that two completely different inventive entities could arrive at identical features for such similar devices. Applicant is respectfully requested to clarify the inventorship of the two applications.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3739

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tetzlaff et al (6,277,117) in view of the teaching of Eggers et al (5,484,436).

Tetzlaff et al disclose a forceps device that provides the identical gap as set forth in the instant applications claims. See column 7, lines 25+. Such a gap is deemed to inherently provide the identical closure pressure, and the device is used in an identical manner to seal tissue. The Tetzlaff et al device, however, is not an endoscopic device.

The examiner maintains that to provide a forceps device for either open or endoscopic procedures is an obvious consideration for one of ordinary skill in the art. In support of this assertion, attention is directed to the Eggers et al device which provides unique jaw members, in this case a scissors device, on either an endoscopic or an open-procedure type instrument (Figures 1 and 2). Eggers et al specifically teach that making such a device into an endoscopic device for use in the body is generally known in the art.

To have provided the Tetzlaff et al forceps device as an endoscopic instrument for use in an endoscopic procedure would have been an obvious consideration for one of ordinary skill in the art, particularly since Eggers et al teach that it is known to provide such instruments in either open-procedure form or endoscopic form.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

Art Unit: 3739

and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 2 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 10/849,432 in view of the teaching of Eggers et al (5,484,436). The only difference between the two sets of claims is the type of instrument. The instant application claims are drawn to an endoscopic instrument, and the '432 application claims are drawn to an open-procedure instrument. Eggers et al fairly teach that it is generally known to provide such a device in either open-procedure (Figure 1) or endoscopic procedure (Figure 2) form to use the device in a variety of situations. To have provided the claims in either form is deemed an obvious design expedient in view of the teaching of Eggers et al.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kihn et al (4,597,379) disclose a forceps device that includes a

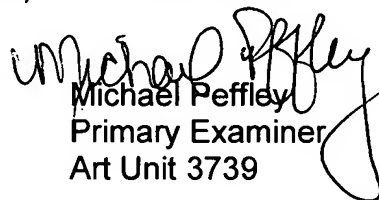
Art Unit: 3739

gap creation pin (78), and Eggers et al (5,891,142) discloses another forceps device that creates a gap with compressed tissue during a sealing procedure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Michael Peffley
Primary Examiner
Art Unit 3739

mp
October 12, 2006